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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/274,781 03/24/99 PEIFFER

H 07456.0009

EXAMINER

IM62/0607

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CHEN, V

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

6

06/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/274,781

Applicant(s)
PEIFFER et al

Examiner
Vivian Chen

Group Art Unit
1773



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-23 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 15 is/are allowed.
- ☒ Claim(s) 1-14 and 16-23 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3, 4-5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 7-12, 14, 17, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over EUROPEAN PATENT APPLICATION 0 602 964 A1 (hereinafter EP '964).

EP '964 discloses a multilayer polyester film comprising of a base layer composed primarily of polyethylene-2,6-naphthalate (PEN) and at least one outer layer composed of a PEN-based copolymer containing 1-5 wt% comonomer having a typical thickness of 0.2-10 μm (line 53, page 2 to line 3, page 3; lines 50-57, page 3) wherein the layers optionally contain pigments (lines 14-17, col. 3) and a functional coating on at least one film surface (page 4) as recited in claims 1-3, 7-12. The film is formed by coextruding the layers, biaxially orienting the film, followed by heat setting and the application of a functional coating such as a metallized or magnetic coating comprising vinyl acetate or polyurethanes (page 4) as recited in claim 14, 16-17, 22. However, the reference does not disclose the recited relationship between the Tg2 values of the individual layers and the film as a whole.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to select the relative Tg2 values of the base layer and outer layers depending on the specific combination of strength, flexibility, and surface properties for a particular application. One of ordinary skill in the art would have used conventional surface treatments to modify the surface tension of the film as indicated in claims 1, 15 in order to optimize the coating and wetting characteristics of the film. The Examiner has reason to believe that a blend of similar materials like two polyesters having different Tg values would typically have a Tg value which is between the Tg values of the individual components as recited in claims 1, 15, therefore the Examiner has basis for shifting the burden of proof to applicant as in In re Fitzgerald et al., 205 USPQ 594.

3. Claims 4-6, 13, 16, 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over EUROPEAN PATENT APPLICATION 0 602 964 A1 (hereinafter EP '964) as applied to claims 1-2 above, and further in view of ULLMANN'S ENCYCLOPEDIA OF INDUSTRIAL CHEMISTRY (hereinafter ULLMANN'S).

EP '964 as relied upon above.

ULLMANN'S discloses that it is well known in the art to use corona discharge treatment to modify the surface properties of a film in order to improve its wettability and adhesion properties (page 92) as recited in claim 13. The reference also discloses that polyester films are commonly used to form packaging for foodstuffs, as a substrate for photographic films, and may

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be metallized, printed, or otherwise treated for electrical, packaging or graphic applications (pages 109-110; Table 3) as recited in claims 16, 18-23.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional surface modifying methods as disclosed in ULLMANN'S to improve the coatability and adhesion properties of the film disclosed in EP '964. It also would have been obvious to utilize the polyester film as disclosed in EP '964 having desirable strength and film handling properties in other applications where polyester films are conventionally used as indicated in claims 18-23. One of ordinary skill in the art would have adjusted the oxygen permeability as indicated in claim 4-6 using conventional means such as coatings or film orientation depending on the barrier properties required for a specific application.

Allowable Subject Matter

4. Claim 15 is allowable over the prior art of record.
5. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or disclose a multilayer polyester film having the recited Tg2 relationship between the individual layers and the film as a whole, wherein the at least one outer layer is composed of a blend of at least 5 wt% ethylene-2,6-naphthalate units and more than 40 wt% ethylene terephthalate units. Specifically, EP '964 precludes the presence of the recited amount of ethylene terephthalate units in the outer layer(s).

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

FRISK (US 5,916,685) discloses polyester films with silicon oxide coatings.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Paul Thibodeau, can be reached on (703) 308-2367.

For Art Unit 1773, the fax phone numbers are as follows:

official faxes:


(703) 305-3601
(703) 305-7718

unofficial faxes:

(703) 305-5436
(703) 305-3602

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (703) 308-0661.

VC
June 5, 2000


Vivian Chen
Primary Examiner
Group 1700